

REMARKS

I. Introduction

Applicants gratefully acknowledge Examiner Wells' courtesy that was extended to Applicants' representative during the personal interview on July 22, 2004. The foregoing amendments and following remarks reflect the substance of the interview. Applicants therefore respectfully request reconsideration of the present application.

II. Status of Claims and Summary of Amendments Thereto

Independent claims 1, 2, 6, and 7 are amended to specify that the claimed heat-generating cosmetic has a viscosity in the range of 30,000 to 100,000 cps. Exemplary support for these amendments can be found in the specification at page 7, line 33 to page 8, line 1. Dependent claims 27 and 28 are cancelled as a consequence of these amendments.

Claims 8, 11, 14, 17-20, 23, 26, and 29 were withdrawn previously by the PTO. During the interview, however, the Examiner kindly clarified that claims 18 and 19 should not have been withdrawn and therefore will be considered on the merits. Claims 1-26 and 29 are therefore pending.

The foregoing amendments do not introduce new matter. Additionally, the amendments eliminate all of the outstanding issues for the reasons below and, in any event, place this application in better condition for appeal. Accordingly, Applicants respectfully request the PTO to enter the amendments.

III. The Office Action

The PTO has now made final the rejections under 35 U.S.C. § 103. For the sake of simplicity, Applicants note that each rejection hinges on at least the combination of EP 0897719 to Franklin et al ("Franklin") and U.S. Pat. No. 5,035,832 to Takamura et al ("Takamura"). Thus, each rejection pertains to the extent that the Franklin and Takamura combination pertains. The PTO here and the Examiner during the interview buttressed the PTO's position by asserting primarily the following motivation to arrive at this combination:

it is permissible in the cosmetic arts to “pick and choose” from Takamura the recited polyoxyalkylene modified organopolysiloxane having two or three alkylene carbon atoms (the “siloxane”) from among many other disclosed silicon-containing compounds for use in the detergent composition that is disclosed by Franklin. To the extent that the rejections may apply to the claims as amended, Applicants respectfully traverse the rejections.

Applicants have argued previously that the PTO has not established a proper *prima facie* case of obviousness because the cited prior art does not teach or suggest all of the claimed elements and because there is no motivation to combine Franklin and Takamura to arrive at the claimed invention. First, none of the cited references teach the recited “heat-generating” claim limitation. *See* Applicant’s Response dated December 16, 2003 at page 10. In the context of an obviousness determination, the PTO must consider whether the prior art teaches or suggests *all* claim limitations. *See* MPEP § 2143.03. Neither Franklin nor Takamura suggest that one of ordinary skill in the art should make heat-generating compositions, much less employ the recited subset of siloxanes that give rise to the heat-generating property.

Second, even if Franklin and Takamura could be modified in the manner proposed by the PTO, the cited combination provides no motivation whatsoever to do so. *See* MPEP § 2143.01. Specifically, Takamura discloses polyoxyalkylene-modified organopolysiloxanes as one possible component among many other silicon-containing compounds. However, the references do not remotely suggest that the recited siloxane should be selected. Absent this suggestion, the PTO’s analysis really hinges on impermissible picking and choosing.

Finally, even if there was sufficient motivation to combine Franklin and Takamura in a way that would render the claimed invention *prima facie* obvious, Applicants’ invention exhibits several unexpected properties that rebut such a mere presumption of obviousness. For example, the claimed composition gives rise to heat-generation in a sustained and controlled manner on account of the presence of the siloxane. *See* specification at page 4, lines 5-6. Additionally, the siloxane imparts to the claimed cosmetic a superior de-aerating property that engenders, for example, beneficial end-user applications and manufacturing ease. *See* specification at page 5, lines 4-7. None of the cited references, alone or in

combination with each other, teach or suggest these unexpected properties of the claimed composition.

For the sole purpose of advancing the prosecution of this application toward allowance, however, the claims are amended to specify that the claimed heat-evolving compositions possess viscosities in the range of 30,000 to 100,000 cps. During the interview, the Examiner indicated that claims so-amended would result in Franklin “falling” as a reference. Applicants agree.

Specifically, Franklin, alone or in combination with Takamura, does not teach or suggest the recited viscosity range. The “paste compositions” of Franklin exhibit viscosities in the range 150,000 to 250,000 cps, preferably 175,000 to 220,000 cps. *See* Franklin at para. 0049. These disclosed viscosity ranges plainly do not overlap the recited range of 30,000 to 100,000 cps. Moreover, the primary reference actually teaches away from the claimed composition in that Franklin consistently points toward viscosity ranges that are higher than that for the claimed composition. Since none of the other references including Takamura disclose or suggest the recited viscosity range, none of the combinations relied upon by the PTO would have suggested this feature of Applicants’ invention. Consequently, a person of ordinary skill in the art would not have considered the claimed heat-evolving cosmetic to be an obvious variant of any of the cited combinations. Accordingly, Applicants courteously urge the PTO to reconsider and withdraw all of the rejections.

IV. Conclusion

Having satisfactorily addressed the outstanding rejections, Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. If the Examiner feels that a telephone interview would advance the prosecution of the present application, the Examiner is invited to contact the undersigned by telephone.

Respectfully submitted,

Date AUG 13 2004

By 

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5414
Facsimile: (202) 672-5399

Richard L. Schwaab
Attorney for Applicant
Registration No. 25,479

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.